



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Nc

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/054,180 04/01/98 REISTAD

B 06543035001

┌

LM02/0412

└

EXAMINER

GARY A WALPERT
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

CAMPA, J

ART UNIT

PAPER NUMBER

2765

4

DATE MAILED:

04/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/054,180

Applicant(s)
Brian J. Reistad et al.

Examiner
John Campa

Group Art Unit
2765



☒ Responsive to communication(s) filed on Apr 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-10 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2765

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, drawn to electronic transaction negotiation systems, classified in class 705, subclass 26.
 - II. Claim 4, drawn to electronic transaction negotiation modules, classified in class 705, subclass 26.
 - III. Claim 5, drawn to electronic transaction fraud-avoidance negotiation system, classified in class 705, subclass 44.
 - IV. Claim 6, drawn to an electronic transaction optimal price negotiation system, classified in class 705, subclass 26.
 - V. Claim 7, drawn to electronic transaction and virtual warehouse processing, classified in class 705, subclass 28.
 - VI. Claim 8, drawn to an electronic gift certificate sale negotiation system, classified in class 705, subclass 14.
 - VII. Claim 9, drawn to an electronic token sale negotiation system, classified in class 705, subclass 39.
 - VIII. Claim 10, drawn to an electronic subscription sale negotiation system, classified in class 705, subclass 1.

Art Unit: 2765

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I through VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

In the instant case, invention I has separate utility over inventions II-VIII such as including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications.

Invention I lacks invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases; invention VIII's

Art Unit: 2765

capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Invention II has separate utility over inventions I and III-VIII such as possessing a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules.

Invention II lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases; invention VIII's capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Art Unit: 2765

Invention III has separate utility over inventions I, II and IV-VIII such as being able to handle fraud-avoidance transaction processing based on parameters other than price, purchaser identity and seller identity.

Invention III lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases; invention VIII's capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Art Unit: 2765

Invention IV has separate utility over inventions I-III and V-VIII such as being able to negotiate down to a certain price in response to an offered price for an item (i.e., a counter offer).

Invention IV lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases; invention VIII's capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Art Unit: 2765

Invention V has separate utility over inventions I-IV and VI-VIII such as being able to negotiate a sale while verifying with a virtual warehouse that the item is available.

Invention V lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases; invention VIII's capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Art Unit: 2765

Invention VI has separate utility over inventions I-V and VII-VIII such as being able to negotiate the sale of gift certificates to two client computers and to store the gift certificate information in a database.

Invention VI lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases; invention VIII's capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Invention VII has separate utility over inventions I-VI and VIII such as being able to negotiate the sale of tokens which can be redeemed for micro-purchases and also being able to

Art Unit: 2765

increase a number of tokens in a token database that are available for use in exchange for the micro-purchases.

Invention VII lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VIII's capability of negotiating the sale of subscriptions and also its capability of updating a subscription table in order to reflect the purchase of a subscription.

Invention VIII has separate utility over inventions I-VII such as being able to negotiate the sale of subscriptions and also being able to update a subscription table in order to reflect the purchase of the subscription.

Art Unit: 2765

Invention VIII lacks invention I's feature of including multiple options in the proposed purchase offer, including in the response to a purchase offer an amendment that includes the selection of an option of at least one of the terms or conditions and cryptographically protecting communications; invention II's feature of a controller module that is capable of processing an order acceptance request and can initiate a plurality of calls to a plurality of plug-in modules that are able to handle processing order acceptance requests and are also capable of being readily replaced by different plug-in modules; invention III's capability of handling fraud-avoidance transaction processing based on parameters other than price and purchaser and seller identity; invention IV's capability of negotiating down to a certain price in response to an offered price for an item (i.e., a counter offer based on price); invention V's capability of negotiating a sale while verifying with a virtual warehouse that the item is available; invention VI's capability of negotiating the sale of gift certificates to two client computers and storing the gift certificate information in a database; invention VII's capability of negotiating the sale of tokens, which can be redeemed for micro-purchases and also the capability of increasing the number of tokens in a token database that are available for use in exchange for the micro-purchases.

See MPEP § 806.05(d).

Examiner notes that regardless of which invention (I-VIII) applicant elects, claim 3 will be examined along with the elected group.

3. Because these inventions are distinct for the reasons given above and the search required for:

Art Unit: 2765

Groups II through VIII is not required for Group I,

Groups I and III through VIII is not required for Group II,

Groups I, II and IV through VIII is not required for Group III,

Groups I through III and V through VIII is not required for Group IV,

Groups I through IV and VI through VIII is not required for Group V,

Groups I through V, VII and VIII is not required for Group VI,

Groups I through VI and VIII is not required for Group VII and

Groups I through VII is not required for Group VIII,

restriction for examination purposes as indicated is proper.

4. A telephone call was placed to reach the applicant's representative, Mr. James E. Mrose, on Tuesday, April 6, at 8:30 a.m. to request an oral election to the above restriction requirement, but examiner was unable to reach applicant's representative. Examiner left a message requesting that Mr. Mrose contact him at his earliest convenience. Mr. Mrose failed to reach examiner after more than three (3) business days had lapsed and accordingly no election was made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 2765

amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Campa whose telephone number is (703) 305-1382. The examiner normally may be reached Monday-Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, may be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit may be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER